

No. 13333.
IN THE
United States Court of Appeals
FOR THE NINTH CIRCUIT

PACIFIC CONTACT LABORATORIES, INC., MORRIS GREEN
and LEE W. HOGGAN,

Appellants,

vs.

SOLEX LABORATORIES, INC.,

Appellee.

APPELLANTS' REPLY BRIEF.

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APPELLANTS' REPLY BRIEF.

Appellants make the following reply to appellee's reply brief.

I.

**The Kalt Corneal Lenses Described in the Obrig Book
Were Not Unsuccessful for Their Normal Purpose of Correcting Visual Error.**

The normal purpose of the Kalt corneal lenses described in the Obrig book was, of course, to correct deficiencies in vision. However, as the Obrig book relates, Kalt also experimented with them in an attempt to use them to reduce the ecstasia of a keratoconus eye affliction, which experiment was described as unsuccessful. The book states:

“They were designed to exert some pressure on the apex of the conus in an attempt to reduce the ecstasia *as well as to correct the visual error.*”

The Obrig book says nothing about the lenses having been unsuccessful to correct visual error. *Consequently, the book must stand as a prior published description of a contact lens which had no scleral band*, so that it only fitted over the cornea; and it must stand as a description of a lens of that character which was of greater curvature than the cornea onto which it was fitted, as otherwise it would not have exerted pressure “on the apex of the conus.” Therefore, appellee’s argument that the Kalt lenses were an unsuccessful experiment is without merit insofar as the value of the Obrig book as a prior publication of the teachings of the Tuohy patent is concerned.

It may be that patentee Tuohy is entitled to some credit for the energy which he devoted to bringing the old Kalt lens before the profession (although he did not represent it to be the work of Kalt), but Tuohy must seek his reward, if any, in some channel other than that provided by the patent statute for inventors.

II.

Appellee Is Estopped to Assert That Tuohy Was the First to Eliminate the Scleral Band of a Contact Lens.

Appellee’s brief appears to argue that Tuohy originated the idea of eliminating the scleral band from contact lenses. However, as pointed out under Point I of appellants’ opening brief, during prosecution of the application for the Tuohy patent, Mr. Tuohy acquiesced in the position of the Patent Office that the Kalt lens described in the Obrig book anticipated the idea of eliminating the scleral band. Consequently, according to the doctrine of “file wrapper estoppel,” appellee may not be heard to assert the contrary.

III.

This Court, as Guardian of the Public Interest in Matters Involving Patents, Should Consider Important Defenses Whether or Not They Were Raised in the Court Below.

Appellee's brief argues that since the issue of whether the Tuohy patent claims comply with Revised Statutes 4888 was not raised until the motion for new trial, this Court may not consider the issue on appeal. However, it has frequently been held that the appellate courts, as guardians of the public interest, should consider important defenses in patent cases even though they were not raised in the lower court.

Muncie Gear Works v. Outboard M. & Mfg. Co.,
315 U. S. 759, 766, 86 L. Ed. 1171;

Nachman Spring-Filled Corp. v. Kay Mfg. Co.,
139 F. 2d 781 (2d Cir.).

IV.

The Tuohy Patent Claims Are Fatally Indefinite.

The Tuohy patent attempts to cover, in rather indefinite language, a corneal lens which is of larger curvature than that of the cornea of the human eye onto which it is eventually to be fitted.

By analogy, one might discover that if one wears a shoe larger than his foot he will not have corns. If such a person could be said to have invented anything, it could only be a method of fitting a shoe on a foot. Certainly he could not, by obtaining an article patent on a shoe larger than the foot of the wearer, place upon shoe makers the burden of following their product through the marketplace and onto the human feet of the eventual purchasers

of the shoes, to determine how the shoes fit. That is precisely the burden which Tuohy is attempting to place upon contact lens makers.

V.

No One Can Be a Wilful Infringer of a Patent of Which He Had No Knowledge and Which Had Not Even Been Applied for When He Commenced His Accused Acts.

In their opening brief, appellants pointed out that, when they commenced making the accused lenses, plaintiff had no patent, and had not even applied for a patent, and that at no time prior to suit (which was filed immediately after issue of the patent) were the defendants notified of the plaintiff's patent. *Appellee has failed to refute or answer that fact.* Therefore, it can hardly be said that the defendants wilfully infringed a patent which did not exist and had not been applied for when they commenced their accused activities. Nor can it be fairly said that defendants' acts in continuing to make the accused lenses after issuance of the patent were in bad faith, when they were never notified of the patent and when they were sued within a few days after issuance of the patent.

Even after issue, if a defendant feels, as do these defendants, that a patent is invalid, the only way in which he can test its validity is to infringe it and invite suit.

“ . . . It is only by becoming an infringer that one gains opportunity to assail a patent in his own interest and that of the public.”

United States Gypsum Co. v. Consolidated Expanded Metal Companies, 130 F. 2d 888, 890 (6th Cir.).

Conclusion.

Wherefore, appellants again submit that the judgment below should be reversed and plaintiff's complaint dismissed.

Respectfully submitted,

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